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EXAMINER

KOSTAK, VICTOR R

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/462,550**

Applicant(s)  
**Burke**

Examiner  
**Victor R. Kostak**

Art Unit  
**2611**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 15, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23, 24, 26-41, 43, and 44 is/are rejected.
- 7) ☒ Claim(s) 25 and 42 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. Claims 37 and 42 are objected to because of the following informalities: the claims must end with a period. Appropriate correction is required.

2. Applicant's amendment filed on 2/15/03 have been fully considered in view of the arguments but it does not overcome the Yoshimura and secondary references used in the previous rejections, explained as follows.

Addressing the gist of applicant's arguments prior to listing the rejection, the feature of "new" or "edited" programming is not recited in any of the claims (and in fact is not brought out in the new Abstract as well, although it seems to be applicant's key distinction). Furthermore, "editing", now argued, has actually been removed from the original claims. The new claims therefore are essentially the same as the previously presented claims.

In so far as "new" programming goes, the term cannot be extended to mean "brand" new, as in an initial generation by an imaging device, because the programming is actually reproduced - or regenerated - from storage.

Because newly generated and/or edited programming is not recited on implied, and since both applicant and Yoshimura generate component elements which form composite programming from storage (so selected by a user) based on classification codes, which applicant does and claims, the previous rejection still applies. The fact that Yoshimura uses a table does not dismiss the fact that he covers applicant's claimed features.

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Regarding another matter, applicant argues both Nagasaka and Heiman for reasons that did not apply to the way they were combined with Yoshimura. Instead of arguing how the secondary reference was combined, applicant argues that the secondary references do not teach what the primary reference teaches (which is, of course, why the examiner first cited the primary reference and then added the secondary references).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23, 24, 26, 32-34, 36, 41, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura et al. (of record).

Reviewing the television system of Yoshimura, (noting particularly Fig. 10) he receives an MPEG formatted data stream (col. 16 lines 46-47), whereby a given program is edited such that each program is first designated according to its genre (Yoshimura develops his description using a music program as an example), which is then further segmented into elements designated as classification items and detail items which are assigned ID data (e.g. Abstract) by the head end. The programming is downloaded with the ID codes and stored (note various storage in Figs. 10, 11 and 14), which enables a user to thus access a program in which specific classification and detail items can be extracted using the classification (ID) codes for display of only those items,

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thereby accommodating the user with a customized display sequence based (col. 14 lines 9-19; col. 17 lines 17-25; col. 18 lines 44-45), and thereby meeting claims 23, 43 and 44.

As for claim 24, the reference type of event, in the example given by Yoshimura, can be the presentation of a specific singer.

As for claim 26, each program element is classified by a subjective assessment (i.e. by movie, type of movie; musical, music group members: note Figs. 2-8).

As for claims 32 and 33, the system of Yoshimura can operate such that only a selected subset of the program elements are transmitted to and stored the receiver (col. 4 line 56 - col. 5 line 15; col. 5 line 32 - col. 6 line 8; col. 7 lines 14-26).

Considering claim 36, the receiver of Yoshimura inherently functions in a manner which displays each received (and/or stored) data segment faster than it takes the data segment to be transmitted to the receiver, or else the image sequence would not be intelligible (it is pointed out that a principle design consideration of video communication requires real-time display rate of the received video stream regardless of any lag in reception).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 35 and 37 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al.

Although Yoshimura does not specify that the stored program segments are combined with the received program elements, it would have been clearly obvious to one of ordinary skill in the art to present the entire program to the user if he so wishes, in the instances when the user decides to view the complete program rather than just segments, or in instances when another members of the household prefer to watch the entire program, thereby meeting claim 35.

As for claim 37, it would also have been obvious to display any program a second, third, fourth, and other times as so desired by the user, to accommodate the user's convenience. This is further suggested by the simple fact that the programming is stored for subsequent reproduction at a time considered suitable by the user.

5. Claims 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. in view of Nagasaka et al. (also of record).

Although Yoshimura does not specify using icons to represent the elements or items, he does state that the user can designate items using a search key from a list table M4 according to color designations (col. 31 lines 49-58), which suggests to one of ordinary skill in the art to use any suitable display representation to assist in identifying respective items. In view of this explicit suggestion and in view of the very similar receiver of Nagasaka, who in fact uses designated icons for identifying program elements (col. 13 lines 52-54), it would therefore have been obvious to

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one of ordinary skill in the art to incorporate any suitable display assistance, such as icons as taught by Nagasaka, for the clear purpose of being more user friendly.

Therefore, regarding claims 27 and 28, Yoshimura describes the order of display being selectable by the user (col. 32 line 1+), which would involve symbols as taught by Nagasaka.

Regarding claim 29, it would have been obvious to present the program segments simultaneously to the viewer for the purpose of enabling ready identification for selecting which segments to expand on or dismiss (provision of a variety of display options being a typical consideration of the system designer), as shown by Nagasaka (Figs. 9, 17).

As for claim 30, both Yoshimura and Nagasaka present the accompanying audio with the video segments (as most programming does).

As for claim 31, as noted above, a primary consideration in designing user selectable A/V programming is in offering as much variety of display options as possible (to thereby accommodate as large a range of tastes and to provide as much control to the user as possible). The related system of Nagasaka includes simultaneous display of the real-time program and still images representing the program segments (Figs. 9 and 17). It would have been obvious to include this display option in the system of Yoshimura as taught by Nagasaka for the clear benefit of providing the user with additional display options which provide the user with ready information to advance the selection process, by displaying information simultaneously.

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6. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. in view of Klosterman et al.

It would also have been obvious to access other related data to a selected program since the programming is arranged of related components, such as singers and subclasses of music (as Yoshimura gives examples thereof), such as further related advertising data for upcoming concerts or merchandise related to the music in question. In view of this and the association between programming selections and advertisement selection taught by Klosterman, who related merchandise associated with programming (e.g. Figs. 3a, 3b), it would therefore have been obvious to include promotional links to encourage viewership.

7. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. in view of Kerman.

It would also have been obvious to gain the viewer's attention when a particular event is considered important, for the clear purpose of making sure that the viewer does not miss the event, as taught by Kerman (e.g. Figs. 4 and 5).

8. Claims 25 and 42 appear allowable over the prior art

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (703)-305-4374. The examiner can normally be reached on Monday through Friday from 6:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile, can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone (703) 306-0377.

**Any response to this final action should be mailed to:**

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**Box AF**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications; please mark "EXPEDITED  
PROCEDURE"; for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington. VA., Sixth Floor (Receptionist).

**Victor R. Kostak**

**Primary Examiner**

*h.v.d.*

VRK

3/11/03